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TRANSMITTAL FORM

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Total Number of Pages in This Submission

Application Number

10/716,174

Filing Date

November 17, 2003

First Named Inventor

Quan Nguyen

Group Art Unit

1641

Examiner Name

Melanie J. Yu

Attorney Docket Number

70-000150US

ENCLOSURES (check all that apply)

- ☐ Fee Transmittal Form
☐ Fee Attached
☐ Amendment / Response
☐ Amendment and Request for Reconsideration
☐ Affidavits/declaration(s)
☐ Extension of Time Request
☒ Receipt Acknowledgement Postcard
☐ Information Disclosure Statement
☐ Certified Copy of Priority Document(s)
☐ Response to Missing Parts/ Incomplete Application
☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ PTO-1449 Form
☐ Cited References
☐ Copy of PCT Search Report
☐ Copy of EP Search Report
☐ Petition to Convert to a Provisional Application
☐ Power of Attorney, Revocation Change of Correspondence Address
☐ Terminal Disclaimer
☐ Small Entity Statement
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- ☒ Interview Summary
☐ Request for Continued Examination (RCE)
☐ Request for Corrected Filing receipt
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☐ Status Letter
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Remarks

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or
Individual name

Jonathan Alan Quine, Reg. No. 41,261, Quine Intellectual Property Law Group, P.C.

Signature

Date

December 13, 2007

CERTIFICATE OF MAILING

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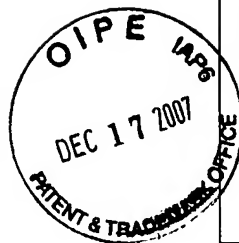
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QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.

By: Kimberly Cheung
Kimberly Cheung

Appl. No. : 10/716,174
Applicant : Quan Nguyen, et al.
Filed : November 17, 2003
TC/A.U. : 1641
Examiner : Melanie J. Yu

Confirmation No. 3901

Docket No. : 70-000150US
Customer No. : 22798

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANTS' INTERVIEW SUMMARY

Dear Sir:

Applicants provide herewith the following Interview Summary to be made of record in the above-identified case:

Participants: Melanie Yu, Long Le, and Monica Elrod-Erickson

Date of Interview: October 16, 2007

Interview Type: Telephonic

Exhibit shown or demonstration conducted: Not applicable

Agreement: Not reached

Claims discussed: Claims 1, 19, 21, 26-29, 33-46, and 304-307

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Applicants note that the substance of the interview was included in a response to the last Office Action, filed November 14, 2007 before the mailing date of the Examiner's Interview Summary. However, the substance of the interview is also briefly outlined below.

Applicants noted that no grounds for objection to claims 26-28 and 33-46 were presented in the Action. The Examiner indicated there were no grounds for objection or rejection to independent claims 36 and 45, and that the dependent claims were objected to as dependent on rejected or withdrawn claims and would be allowable if rewritten or amended. The Examiner advised that Applicants wait for the Examiner's decision on the next point, regarding restriction and withdrawal of claims 304-307, before rewriting the claims.

With respect to claims 304-307 and the alleged election by original presentation noted in the Action, Applicants discussed with the Examiner that claims 304-307 are directed to an invention originally claimed and already examined in four previous office actions. Applicants noted that the claims should therefore not be withdrawn. Applicants requested issuance of a formal restriction requirement if the Examiner decides to restrict the claims at this stage.

The art by Burbaum, Walker, and Ting was discussed with respect to the rejection of independent claim 1 under 35 USC 103 and lack of motivation to combine these references. Applicants noted that Burbaum describes sensors for secreted reporter enzymes. Walker describes caged peptides that inhibit calmodulin/MLCK activity and is thus focused on control of protein activity; there is no suggestion from Walker that other compounds should be injected into cells to detect activity inside the cell. In Ting, there is no suggestion that the constructs of Ting can be controlled by caging, nor is there any mention of the desirability of such control.

The art by Ting, Burbaum, Walker, and Ladner was discussed with respect to the rejection of independent claims 1, 21 and 29 under 35 USC 103 and lack of motivation to combine these references. Applicants noted the distinction between in vitro ribosomal peptide synthesis as taught by Ladner and in vitro chemical peptide synthesis as would be required by Walker and Burbaum. Applicants further noted that one of skill would therefore not be motivated to combine the references as suggested because they can not be combined as suggested.

In addition, Applicants noted that, even if the constructs of Ting could be caged as suggested, no reason for doing so based on the art has been shown. The rationale Walker states in their introductory paragraph for caging their peptides is that peptide inhibitors can be used to inhibit protein activity but the peptides have to be micro-injected into cells and microinjection can alter cell function; caging permitted Walker to inactivate the inhibitory peptide, inject it, ensure the cell was functioning normally, and then uncage and inhibit protein activity. The polypeptide constructs of Ting are already produced in vivo — specifically to avoid the need to introduce the protein into the cell. There is simply no reason why one of skill in the art would take the construct of Ting out of the cell by making it in vitro, cage it, and then put it back into the cell to try to avoid problems caused by injecting it into the cell when it was

already in one.

Applicants further noted that no reason based on the art for caging a sensor inside a cell has been demonstrated.

With respect to claim 21, Applicants noted that the constructs of Ting function in the opposite manner from those of claim 21.

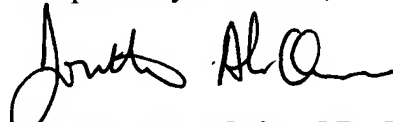
With respect to claim 19, Applicants noted that in Kris, when a labeled antibody binds to a substrate, the labeled antibody and the substrate are still two separate polypeptides, not a single polypeptide.

Applicants are providing this Applicants' Interview Summary in response to the Interview Summary mailed November 23, 2007. As such, Applicants are responding within the ONE MONTH provided by the Interview Summary. A response to the Office Action has previously been provided in a separate document, mailed November 14, 2007.

If the Examiner believes a telephone conference would further expedite prosecution of this application, please telephone Monica Elrod-Erickson at 510-337-7871.

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Respectfully submitted,



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